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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/314,738	05/19/1999	SHOLOM S. ROSEN	0225-4185	5587
27123	7590	12/15/2004	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			BARRON JR, GILBERTO	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/314,738

Applicant(s)

ROSEN, SHOLOM S.

Examiner

Gilberto Barron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The response filed August 2, 2004 has been carefully considered and Applicant's argument that there is no outstanding issue on the merits to warrant the determination of whether (or not) the 35 USC § 112, ¶ 1, requirements pursuant to a 35 USC ¶ 120 priority claim have been met, is persuasive. In order to properly present a necessary issue, this Office Action newly presents grounds of rejection under 35 U.S.C. 102(e) based on the Hiroya et al patent.
2. The Request for Interference will be appropriately forwarded for determination of the question of declaring an interference upon Applicant furnishing the requirements of 37 CFR § 1.608(b), MPEP 2308. The response filed August 2, 2004 was not in accordance with the requirements of MPEP 2308 which require that "one or more affidavits which demonstrate that applicant is prima facie entitled to a judgment relative to the patentee and an explanation stating with particularity the basis upon which the applicant is prima facie entitled to the judgment".

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hiroya et al. (5,754,654).

Applicant has copied claims to provoke an interference with the Hiroya patent. Therefore the claims are claiming the same invention as the Hiroya patent and are clearly anticipated.

Applicant's arguments regarding the support for the claim limitations are persuasive with respect to the filing date of the instant application. However, Applicant's argument for priority to parent application 08/234,461 is not persuasive.

In particular, the electronic ticket storage device of claims 1, 6, and 11 does not have support in the written description of the parent application as recited in the instant claims. The limitations of the instant claims recite that the electronic ticket storage device stores electronic money, an electronic ticket, and a transaction history including transactions of electronic money and electronic tickets, and where said transaction history is updated, by a program stored in

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said electronic ticket storage device, after a transfer of either electronic money or an electronic ticket.

The disclosure of the parent application is directed to a transaction device comprising a trusted agent and a money module. This arrangement for separate trusted agent and money module components, is in keeping with the objectives of the instant application for a flexible, anonymous and trusted electronic system, see Summary of the Invention of 08/234,461.

Applicant arguments are not persuasive in showing how the proposed claims, which set forth an invention that teaches away from separate components, could be supported by the disclosure of the parent application that describes an invention having separate components, and the benefits and uses of the invention that is comprised of the separate components. Part of Applicant's Request for Interference indicates that the functions of the money module are supported by an earlier parent application, which provides a description of the money module as a completely separate component.

The claimed electronic ticket storage means further requires an update feature and a transaction log history having the information for both electronic money and electronic tickets. The disclosure of the parent application appears to disclose separate transaction history logs and a different update function in keeping with the nature of the separate components of trusted agent and money module.

In addition to the lack of support for the electronic ticket storage device, claims 6-10 recite steps of sending, receiving, and recording of electronic tickets

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and money. However, these steps are not supported by the disclosure of the parent application. The said disclosure of the parent application appears to disclose sending and receiving tickets through the trusted agents, first, and then the sending and receiving of the electronic money, second. Further, the recording step is not disclosed. The said disclosure of the parent application does establish a commit function, but this does not appear as a recording step as necessitated by the instant claims.

The portion of the specification from the parent application pointed to as describing money module and trusted agent fabricated as a single tamper proof module does not provide a written description for the claimed invention of a electronic ticket storage means or device that stores electronic money, electronic ticket(s) and a transaction history. The specification of the parent application describes an invention that provides for separate storage of electronic money, electronic ticket(s) and separate transaction histories for each. The written description of the parent application describes separate communications between money modules and trusted agents. The description of the parent application indicates that a fabrication of trusted agent and money module as a single tamper proof module would eliminate the requirement for secure communications between a money module and a trusted agent, but nevertheless continues to describe the separate communications between money modules from customer to merchant, and trusted agents from merchant to customer, and separate transaction histories for each. Further, the description of the invention of the parent application indicates that transaction device, Figure 3, #122, includes

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three components, host processor, 124, trusted agent 120 and money module 6.

While the invention of the instant claims requires a terminal means separate from the electronic ticket storage means. The specification of the parent application does not support a terminal means separate from the electronic ticket storage means.

5. Applicant has requested that an interference proceeding be declared and the Applicant be named senior party based on the effective filing date of the earlier parent application 08/234,461. However, the instant application has only been accorded the filing date of 5/19/1999 based on the lack of support in the earlier parent application.

6. Applicant is advised that the patent cannot be overcome by an affidavit or declaration under 37 CFR 1.131 but only through interference proceedings.


The applicant is further advised that an affidavit under 37 CFR 1.608(b) or evidence and an explanation under 37 CFR 1.608(b), as appropriate, must be submitted to proceed with the proposal of interference proceedings.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilberto Barrón Jr. whose telephone number is (703) 305-1830. The examiner can normally be reached on Mondays thru Thursdays from 8:00 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

The fax phone number for OFFICIAL responses for the organization where this application or proceeding is assigned is (703) 872-9306

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
GILBERTO BARRÓN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100